

REMARKS

Applicants have amended the claims as indicated above in response to a Decision of the Board issued January 13, 2009. The Board Decision contained a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). The status of the claims after the present amendment is as follows:

Claims 2, 8, 18, 20, 23, 24, 26, 29, 33, 37, 69, 70, 73, 74, 76, 78, 81, 84, 85, 89, 90 and 93 - 95 are presently amended.

Claims 3, 4, 7, 11, 12, 22, 28, 35, 68, 72, 77, 80, 83, 88, 92, 98, 103 and 104 are presently canceled.

Claims 1, 19, 31, 32 and 43 - 66 were previously canceled.

Claims 2, 5, 6, 8 - 10, 13 - 18, 20, 21, 23 - 27, 29, 30, 33, 34, 36 - 42, 67, 69 - 71,, 73 - 76, 78, 79, 81, 82, 84 - 87, 89 - 91, 93 - 97 and 99 - 102 remain pending.

In the Decision, claims 2 - 6, 11 - 17, 20 - 22, 26 - 30, 37 - 42, 67, 68, 70 - 72, 76 - 80, 82, 83, 85 - 89 and 91 - 93 are rejected by the Board under the judicially created doctrine of obviousness-type double patenting over claims 1 and 3 of U.S. Patent 4,694,490 and U.S. Patent 4,488,179 ("Krüger"). Applicants have amended the claims to address this new ground of rejection.

I. SUMMARY OF AMENDMENTS

A. INDEPENDENT CLAIM 2 AND CLAIMS DEPENDING THEREFROM

Independent claim 2 has been amended to set forth that the portion of the recited plurality of signals received from source external to the receiver station is a first medium received in a digital data channel. Claim 11, which depended from claim 2 and set forth that the plurality of signals includes a digital channel, and claim 12, which depended from claim 11 and set forth that the receiver station receives the first medium in a digital data channel, have been canceled as the subject matter of these claims is now incorporated into independent claim 2. Independent claim 2 has been further amended to incorporate the subject matter of claim 4, which in turn depends from claim 3. Accordingly, claims 3 and 4 are canceled by the present amendment. Independent claim 2 is also amended to incorporate the subject matter of claim 7.

Claim 7 is thus canceled. Claim 18 is amended to maintain consistency with the amendment to claim 2.

B. INDEPENDENT CLAIM 20 AND CLAIMS DEPENDING THEREFROM

Independent claim 20 has been amended to set forth a step of receiving the recited second medium in a digital data channel from a source external to the receiver station. Claim 20 is further amended to clearly set forth that the limitations of identifying content, generating information and controlling the presentation are performed through a microcomputer at the receiver station. Claim 22, which set forth a step of receiving the second medium in a digital data channel has been canceled as that subject matter is now incorporated into independent claim 20. Claim 23 is amended to maintain consistency with the amendment to claim 20.

C. INDEPENDENT CLAIM 24 AND CLAIMS DEPENDING THEREFROM

Independent claim 24 has been amended to include the subject matter of dependent claim 103. Accordingly, claim 103 has been canceled.

D. INDEPENDENT CLAIM 26 AND CLAIMS DEPENDING THEREFROM

Independent claim 26 has been amended to set forth that the second medium is received in a digital data channel from a remote transmitter station. Claim 83, which depended from claim 26 and set forth that the second medium is received in a digital data channel, has been canceled as this subject matter is incorporated into claim 26. Claim 26 is further amended to incorporate the subject matter of claim 28. Claim 28 is thus canceled. Claim 84 is amended to maintain consistency with the amendment to claim 26.

E. INDEPENDENT CLAIM 29 AND CLAIMS DEPENDING THEREFROM

Independent claim 29 has been amended to set forth that the recited execution of processor instructions to create a series of discrete video images includes processing data received in a second medium from an external source. Claim 92 directed processing data received in a second medium has been canceled as this subject matter is incorporated into claim

29. Claims 93 and 94 which previously depended from canceled claim 92 are amended to depend directly from claim 29.

F. INDEPENDENT CLAIM 33 AND CLAIMS DEPENDING THEREFROM

Independent claim 33 has been amended to include the subject matter of dependent claim 35. Accordingly, claim 35 has been canceled.

G. INDEPENDENT CLAIM 37 AND CLAIMS DEPENDING THEREFROM

Independent claim 37 has been amended to include similar limitations as those added to claim 2. Claim 37 is amended to make clear that the recited microprocessor determines content of the second medium. Claim 37 is amended to set forth that the first medium is received in a digital data channel. Further claim 37 is amended to set forth that the content of the second medium explains the significance of the presentation using the information from the first medium. Claim 68, which depended from claim 37 and set forth that the microcomputer receives the first medium in a digital data channel, has been canceled as this subject matter is incorporated into claim 37. Dependent claim 69 is amended to maintain consistency with the amendment to claim 37.

H. INDEPENDENT CLAIM 70 AND CLAIMS DEPENDING THEREFROM

Independent claim 70 has been amended to include similar limitations as those added to claim 20. Claim 70 is amended to set forth that the microcomputer receives the second medium in a digital data channel transmitted from a source external to said multimedia presentation apparatus. Claim 70 is also amended to make clear that the microcomputer does identify content of the second medium and generate information based on the second medium. Claim 72, which depended from claim 70 and set forth that the microcomputer receives the second medium in a digital data channel, has been canceled as this subject matter is incorporated into claim 70. Dependent claim 73 is amended to maintain consistency with the amendment to claim 70.

I. INDEPENDENT CLAIM 74 AND CLAIMS DEPENDING THEREFROM

Independent claim 74 has been amended to include the subject matter of dependent claim 104. Accordingly, claim 104 has been canceled.

J. INDEPENDENT CLAIM 76 AND CLAIMS DEPENDING THEREFROM

Independent claim 76 has been amended to include similar limitations as those added to claim 26. Independent claim 76 has been amended to set forth that the second medium is received in a digital data channel from a source external to the presentation apparatus. Claim 80, which depended from claim 76 and set forth that the second medium is received in a digital data channel, has been canceled as this subject matter is incorporated into claim 76. Claim 76 is further amended to incorporate the subject matter of claim 77. Claim 77 is thus canceled. Claim 81 is amended to maintain consistency with the amendment to claim 76.

K. INDEPENDENT CLAIM 85 AND CLAIMS DEPENDING THEREFROM

Independent claim 85 has been amended to include similar limitations as those added to claim 29. Independent claim 85 has been amended to set forth that the microcomputer for creating a series of discrete video images by executing processor instructions includes processing data received in a second medium from an external source. Claim 88 directed to processing data received in a second medium has been canceled as this subject matter is incorporated into claim 85. Claims 89 and 90 which previously depended from canceled claim 88 are amended to depend from claim 85.

L. INDEPENDENT CLAIM 95 AND CLAIMS DEPENDING THEREFROM

Independent claim 95 has been amended to include the subject matter of dependent claim 96. Accordingly, claim 96 has been canceled.

II. RESPONSE TO NEW GROUND OF REJECTION

The Board in the new ground of rejection analyses the differences between claims 1 and 3 of U.S. Patent 4,694,490 ('490 Patent) and the presently pending claims. Applicants respectfully request that the rejection of claims 2, 5, 6, 13 - 17, 20, 21, 26 - 27, 30, 37 - 42, 67 70

- 71, 76, 78, 79, 82, 85 - 87, 89, 91 and 93 be reconsidered and withdrawn in light of the fact that claims 1 and 3 of the '490 Patent have been canceled in reexamination proceeding 90/006,800 and, alternatively, in light of the above claim amendments.

A. THE INSTANT CLAIMS DO NOT CONSTITUTE AN IMPROPER EXTENSION OF A VALID PATENT CLAIMS

On December 18, 2008, the Board denied Appellants' request for rehearing in Appeal No. 2008-0334, affirming the Examiner's rejections of claims 1-9 and 11 in the '490 Patent as unpatentable. The December 2008 Decision regarding the '490 Patent is submitted with this amendment for the Examiner's review. The Board's decision in the appeal of the '490 Patent became final on February 18, 2009, when Appellants failed to lodge an appeal to the Federal Circuit. Accordingly, the claims at issue in that appeal are now effectively canceled and void *ab initio*. Those canceled claims cannot be the basis for a double patenting rejection as the subject matter recited in claims 2, 5, 6, 13 - 17, 20, 21, 26 - 27, 30, 37 - 42, 67 70 - 71, 76, 78, 79, 82, 85 - 87, 89, 91 and 93 would not constitute an extension of a valid claim of an existing or expired U.S. patent.

The U.S. Court of Appeals for the Federal Circuit summarized the legal basis for double patenting rejections as follows:

A double patenting rejection precludes one person from obtaining more than one valid patent for either (a) the "same invention," or (b) an "obvious" modification of the same invention. (emphasis added)

In re Longi, 759 F.2d 887, 892, 225 USPQ 645, 648 (Fed. Cir. 1985). *See also, In re Byck*, 48 F.2d 665, 9 USPQ 205 (CCPA 1931) ("It is elementary that there can not be more than one valid patent for the same invention") (emphasis added); *Pequignot v. Solo Cup Co.*, 540 F.Supp.2d 649, 653, 87 USPQ2d 1365, 1369 (E.D.Va. 2008)("a patentee may not obtain 'more than one valid patent'"); *Takeda Pharmaceutical Co. v. Dudas*, 511 F.Supp.2d 81, 95, 84 USPQ2d 1365, 1376 (D.D.C. 2007)("The double patenting doctrine precludes a patentee from ... obtaining more than one valid patent for either the 'same invention' or an 'obvious' modification of the same invention") (emphasis added).

For obviousness-type double patenting, the Federal Circuit has explained that

[t]he purpose of this rejection is to prevent the extension of the term of a patent, even where an express statutory basis for the rejection is missing, by prohibiting the issuance of the claims in a second patent not patentably distinct from the claims of the first patent.

In re Longi, 759 F.2d at 892; 225 USPQ at 648.

The Decision in the instant application asserts a new ground of rejection based on obviousness-type double patenting. The Decision finds that claims 2, 5, 6, 13 - 17, 20, 21, 26 - 27, 30, 37 - 42, 67 70 - 71, 76, 78, 79, 82, 85 - 87, 89, 91 and 93 are patentably indistinct from the inventions defined in claims 1 and 3 of the '490 Patent in view of Krüger. Claims 1 and 3 of the '490 Patent, however, were canceled in the Board's decision in Appeal No. 2008-0334 regarding Reexamination Control Number 90/006,800. Since cancellation of claims found unpatentable in reexamination results in those claims being void *ab initio*, those claims can not constitute the basis for a double patenting rejection because the pending claims can not now constitute an improper extension of a valid patent claim.

In an unpublished decision, *Standard Havens Prods., Inc. v. Gencor Indus.*, 996 F.2d 1236, 27 USPQ2d 1959 (Fed. Cir. 1993) the Federal Circuit reversed the District Court's denial² of a stay subsequent to a completed reexamination proceeding on the basis that the cancellation of a claim in a reexamination proceeding voided that claim *ab initio*.³ In effect, cancellation in reexamination means that the subject matter defined by the claim has been deemed by the Patent and Trademark Office ("PTO") never to have been patentable. Once the PTO's cancellation of claims 1 and 3 of the '490 Patent becomes final, those claims are void -- they never existed.

² *Standard Haven Prods., Inc. v. Gencor Indus.*, 810 F. Supp. 1072, 25 USPQ2d 1949 (W.D. Mo. 1993); Compare *MercExchange LLC v. eBay, Inc.* 500 F.Supp 2d 556, 83 USPQ2d 1688 (E.D. Va 2007).

³ 'Void *ab initio*' is a well recognized legal doctrine in federal jurisprudence. "Void" is defined in Black's Law Dictionary, Eight Edition (2004) as "of no legal effect, null" and "void *ab initio*" as "null from the beginning, as from the first moment when a contract is entered into." The doctrine is applied in many legal contexts to render a legal instrument completely ineffective and totally without force and effect from the time of its grant or execution. Specific examples, are (1) government contracts tainted by improper influence *United States v. Mississippi Valley Generating Co.*, 364 U.S. 520, 563 (1961); (2) state court orders entered without jurisdiction because of removal to federal court, *Steamship Co. v. Tugman*, 106 U.S. 118, 122 (1882); (3) state court orders attempting to modify bankruptcy stays, *In re Gruntz*, 202 F.3d 1074, 1082 n.6 (9th Cir. 2000); (4) money claims granted by Bureau of Land Management when required stipulations not filed, *American Colloid Co. v. Babbitt*, 145 F.3d 1152 (10th Cir.

Accordingly, the cancelled claims cannot be the basis for a double patenting rejection with respect to the pending claims at issue here because the predicate for the rejection, unlawful extension of patent rights, simply does not exist. Under such circumstances, claims 2, 5, 6, 13 - 17, 20, 21, 26 - 27, 30, 37 - 42, 67 70 - 71, 76, 78, 79, 82, 85 - 87, 89, 91 and 93 are not an extension of a patent monopoly because claims 1 and 3 of the '490 Patent never existed and never established any such monopoly. Put another way, as the claims that are the basis for the double patenting rejection are void *ab initio*, there is nothing for the present claims to extend. See, *In re Translogic Tech., Inc.*, 504 F.3d 1249, 84 USPQ 1929 (Fed. Cir. 2007) and *Gould v. Control Laser Corp.*, 705 F.2d 1340, 217 USPQ 985 (Fed. Cir. 1985) wherein the Court noted that cancellation voiding a patent claim terminates a district case proceeding as to the cancelled claim.

Obviousness-type double patenting is a judicially created doctrine and not a creature of statute. The doctrine is distinct from same invention double patenting which is based on the language of 35 U.S.C. §101 that each invention shall be the basis for a separate patent. The entire justification for the doctrine is the alleged extension of patent protection by granting a patent including a claim which is patentably indistinct from a valid claim of an existing patent. When that justification is removed as here, the Board has no valid basis for affirming the double patenting rejection.

Finally, the present situation is akin to one in which an applicant for a patent files a first application in which the claims are finally rejected and then files a continuation application to present amended claims. The earlier rejected application and its claims do not and cannot be used as a basis for rejecting the claims of the continuation.

Based on the new evidence that claims 1 and 3 of the '490 Patent stand as canceled in the reexamination proceeding of the '490 Patent, the rejection of claims 2, 5, 6, 13 - 17, 20, 21, 26 - 27, 30, 37 - 42, 67 70 - 71, 76, 78, 79, 82, 85 - 87, 89, 91 and 93 on the basis of double patenting over claims 1 and 3 of the '490 Patent should be withdrawn.

1988); (5) interim patent term extension orders when requisite conditions not met, *In re Reckitt & Coleman Prods.*, 2 U.S.P.Q.2d 1450 (Comm'r Pats. 1987).

B. THE INSTANT CLAIMS AS AMENDED ARE NOT OBVIOUS OVER THE '490 CLAIMS IN VIEW OF KRÜGER

Applicants have amended the claims to avoid the new grounds of double patenting rejection. The claims rejected under the new ground of double patenting rejection are generally directed to methods and apparatus for outputting multimedia presentations where the multiple media are received and identified for proper coordination. The rejected independent claims have generally been amended to include a recitation of the reception of a medium in a digital data channel from an external source. Claims 1 and 3 of the '490 Patent in view of Krüger fail to teach or suggest this limitation.

Independent claims 2, 20, 26, 29, 37, 70, 76 and 85 each stand rejected under the new ground double patenting rejection as being unpatentable over claims 1 and 3 of the '490 Patent in view of Krüger. These claims generally set forth multiple media. For example, claim 2 sets forth a plurality of signals including at least two media. The Decision notes that claim 1 of the '490 Patent includes a "video signal" relied upon to teach a first medium and "user specific information" relied upon to teach a second medium. Decision at 152. Nothing in claims 1 and 3 of the '490 patent teaches or suggests that the input data stored as "user specific information" is received in a digital data channel from an external source. The secondary reference to Krüger does not correct for this deficiency of the teaching of claims 1 and 3.

Claims 12, 22, 83, 93, 68, 72, 80 and 89 (now canceled), depended from independent claims 2, 20, 26, 29, 37, 70, 76 and 85 respectively, each set forth receiving a medium in a digital data channel. These claims were subject to the new ground of rejection. For example, with respect to claim 12 the Decision states:

One of ordinary skill in the computer art would have had sufficient knowledge that it would have been obvious to receive the "user specific information" in '490 patent claim 1, which corresponds to a first medium, over a "digital data channel" because the "user specific information" is digital data stored in a computer and must somehow be received from outside the computer. A "channel" is any data path and could be the path from the computer keyboard to the computer. These claims do not require a data source external to the receiver.

Decision at 159-60. The Board thus reasons that the “user specific information” must be received in a digital data channel,⁴ but expressly recognizes that no details of this “digital data channel” are taught by claims 1 and 3 of the ‘490 Patent. The Board expressly notes that features of the “digital data channel” such as reception from a source external to the receiver are not set forth in the claims. The rejected claims are presently amended to set forth this limitation. Thus, in accordance with the reasoning set forth by the Board in the Decision, claims 1 and 3 of the ‘490 Patent do not teach or suggest receiving a medium in a digital data channel from a data source external to the receiver. Krüger is not relied upon to teach or suggest any details of the “user specific data.” Krüger in fact is directed to an “apparatus for television viewing that makes it possible for the viewer to display on a television screen not only signals received by radio or cable but signals reproduced from record or provided by a local camera, or to call into play a videotext device or a television game apparatus.” Krüger col. 1, ll. 4-9. This auxiliary content of Krüger, as shown by Figure 2, is received from local apparatus. There is no suggestion in Krüger to receive the “user specific information” as recited in claim 1 of the ‘490 Patent from an external source.

Applicants further note that claims 18, 23, 84, 94, 69, 73, 81 and 90, depending from claims 2, 20, 26, 29, 37, 70, 76 and 85 respectively, each set forth that a medium is received in a digital data channel of a multichannel cable transmission. These claims are not subject to the new double patenting rejections. For instance, with respect to claim 18 the Decision states:

Claim 18 is not rejected because the user specific information in ‘490 patent claim 1 is not received in a multichannel cable transmission and this is not taught by Krüger.

Decision at 160. This passage confirms that details regarding how the user specific information of claim 1 of the ‘490 patent are received are not obvious in view of Krüger. Accordingly, applicants respectfully submit that neither claim 1 of the ‘490 Patent nor Krüger teach that the “user specific information” is received in a digital data channel from an external source.

⁴ Applicants’ do not accede to the proposition that any “user specific information” stored at a computer must be received in a digital data channel. For example, stored information could be generated by the computer. However, applicants do agree that stored “user specific information” requires some user specific data to be input to the computer at some point in time.

For the above reasons, as set forth in detail below, applicants respectfully request that the rejections of 2, 5, 6, 13 - 17, 20, 21, 26 - 27, 30, 37 - 42, 67 70 - 71, 76, 78, 79, 82, 85 - 87, 89, 91 and 93 on the basis of double patenting over claims 1 and 3 of the '490 Patent in view of Krüger should be withdrawn.

1. Claim 2 and Claims Depending Therefrom

Claim 2 as amended sets forth “*a first medium received in a digital data channel from a source external to said receiver station.*” Claim 2 has been amended to include the subject matter previously set forth in dependent claims 11 and 12 and further to set forth that the first medium is received from a source external to the receiver station. As explained above, claims 1 and 3 of the '490 Patent in view Krüger do not teach or suggest any details of the reception of the first medium and, thus, do not teach or suggest that the first medium is received in a digital data channel from a source external to the receiver station. Additionally, as discussed above, claims 1 and 3 of the '490 Patent cannot form the basis of a double patenting rejection as these claims have been finally determined to be unpatentable during reexamination. Accordingly, for these reasons, applicants respectfully request that the new ground of double patenting rejection against claim 2 be withdrawn.

Claim 2 is further amended to place this claim in a condition for allowance over rejections affirmed by the Board on appeal. As explained below, the amendments incorporate limitations which the Board found to avoid the applied art. Claim 2 stands rejected under 35 U.S.C. § 102(b) as being anticipated by German Patent Publication DE 2,904981 (“Zaboklicki”). Decision at 61-69. The Board, however, reversed the rejection of claim 7, dependent from claim 2, as being anticipated by Zaboklicki. Decision at 69-70. Claim 2 is amended to include the subject matter of claim 7 by setting forth that “*said content of said second medium explains a significance of said presentation using said information.*” Claim 2 as amended is thus not anticipated by Zaboklicki. Accordingly, this amendment avoids the teaching of Zaboklicki without raising new issues for consideration by the Examiner. Applicants respectfully request that the rejection of amended claim 2 as being anticipated by Zaboklicki be withdrawn consistent with the holding of the Decision.

Claim 2 also stands rejected under 35 U.S.C. § 103(a) as being obvious over Japanese Patent Publication JP 55-045248 (“Tsuboka”) in view of Gary Robinson and William Loveless, “*Touch-Tone Teletext, A Combined Teletext-Viewdata System*,” IEEE Trans. on Consumer Electronics, Vol. CE-25, No. 3, July 1979 (“Robinson”). Claim 4, dependent on claim 3, set forth that the computer performs the step of determining. Claim 3, dependent on claim 2, set forth that the information from the first medium is stored in the computer. Claim 4 is not rejected as being obvious over Tsuboka in view of Robinson. The Decision recognizes:

The step of “determining content of a second medium” is broadly met by a human viewer determining “content” by viewing and listening to the television program. . . . Claim 2 does not recite how the determining step is performed or what the “content” consists of, so this interpretation that a human viewer determines content is not unreasonable. Compare claim 4 where a computer performs the determining step, and note that claim 4 is not included in this rejection.

Decision at 117-18. Claim 2 is amended to include the subject matter of claim 4. Claim 2 is amended to set forth storing the information from the first medium in a storage medium at a computer at the receiver station equivalent to the recitation of claim 3. Claim 2 is further amended to clearly set forth that the step of determining content is performed by the computer. Thus, in accordance with the reasoning set forth in the Decision, claim 2 as amended is patentable over Tsuboka in view of Robinson. Neither Tsuboka nor Robinson teach or suggest a step of determining content through use of processor instructions resident on the computer at the receiver station. Accordingly, these amendments avoid the teachings of Tsuboka and Robinson without raising new issues for consideration by the Examiner. Applicants respectfully request that the rejection of claim 2 as being unpatentable over Tsuboka in view of Robinson be withdrawn consistent with the holding of the Decision.

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over J. Hedger, *Telesoftware: Home Computing via Broadcast Teletext*, IEEE Trans. on Consumer Electronics, Vol. CE-25, No. 3, July 1979, pages 279-97 (“Hedger”) in view of Hartford Gunn and Gregory W. Harper, *A Public Broadcaster’s View of Teletext in the United States*, conference held 26-28 Mar. 1980 in London (“Gunn”) and British Patent Publication GB

1,405,141 (“Yoshino”). The Decision again affirms this rejection on the basis that the step of determining content is not recited as being performed by a computer.

The step of “determining content of a second medium” broadly reads on the viewer receiving verbal instructions in the “Wall Street Week” example in Gunn.

Decision at 138. Claim 4 was not rejected as unpatentable over Hedger in view of Gunn and Yoshino. The amendment to claim 2 to include the subject matter of claim 4 thus renders claim 2 patentable over Hedger in view of Gunn and Yoshino. None of Hedger, Gunn or Yoshino teach or suggest a step of determining content through use of processor instructions resident on the computer at the receiver station. Accordingly, the amendments to claim 2 avoid the teachings of Hedger, Gunn and Yoshino without raising new issues for consideration by the Examiner. Applicants respectfully request that the rejection of claim 2 as being unpatentable over Hedger in view of Gunn and Yoshino be withdrawn consistent with the holding of the Decision.

Claims 5, 6, 8-10 and 13-18 depend from claim 2. These claims are patentable for the reasons set forth above with respect to claim 2. It should be noted that claims 9 and 10 stand allowable in the Decision. Applicants respectfully request that the rejections of claims 5, 6, 8 and 13-18 be withdrawn. The cancelation of claims 3, 4, 7, 11 and 12 renders the rejections of these claims moot.

2. Claim 20 and Claims Depending Therefrom

Claim 20 as amended sets forth “*receiving said second medium in a digital data channel from a source external to said receiver station.*” Claim 20 has been amended to include the subject matter previously set forth in dependent claim 22 and further to set forth that the second medium is received from a source external to the receiver station. As explained above, claims 1 and 3 of the ’490 Patent in view Krüger do not teach or suggest any details of the reception of the second medium and, thus, do not teach or suggest that the second medium is received in a digital data channel from a source external to the receiver station. Additionally, as discussed above, claims 1 and 3 of the ’490 Patent cannot form the basis of a double patenting rejection as these claims have been finally determined to be unpatentable during reexamination.

Accordingly, for these reasons, applicants respectfully request that the new ground of double patenting rejection against claim 20 be withdrawn.

Claim 20 is further amended to place this claim in a condition for allowance over rejections affirmed by the Board on appeal. As explained below, the amendments incorporate limitations which the Board found to avoid the applied art. Claim 20 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Zaboklicki. Decision at 70-73. Claim 20 is a process claim that is generally equivalent to apparatus claim 70. Claim 20 is amended to more closely correspond to claim 70. Claim 70 is not rejected as anticipated by Zaboklicki. A significant difference between claim 20 as considered by the Board and claim 70 is that claim 70 expressly sets forth that the microcomputer executes processor instructions to enable a coordinated presentation of the first medium and information based on the second medium, while claim 20, as interpreted by the Board, did not.

In the limitation “controlling said receiver station, based on said step of identifying, to enable a coordinated presentation, through execution of processor instructions, of said first medium and information based on said second medium, wherein, said information based on said second medium is generated based on identifying content of said second medium,” we find that Zaboklicki describes a coordinated presentation consisting of the television video (“first medium”) and audio (“information based on said second medium”), where the “second medium” is teletext data including telesoftware and identification data. That is, audio is selected to presented with a video fragment “based on” telesoftware and identification data **and the viewer’s selection.**

Decision at 72 (emphasis added). The amendment of claim 20 to more closely correspond to claim 70 sets forth *controlling a microcomputer at the receiver station, through execution of processor instructions to identify content of the first medium, identify content of the second medium, generate information and coordinate presentation of the first medium and information based on the second medium.* Zaboklicki does not disclose controlling a microcomputer, through execution of processor instructions, to coordinate presentation of the first medium and information based on a second medium. Claim 20 as amended is not anticipated by Zaboklicki for the same reasons that claim 70 is not anticipated by Zaboklicki. Accordingly, this amendment avoids the teaching of Zaboklicki without raising new issues for consideration by

the Examiner. Applicants respectfully request that the rejection of claim 20 as being anticipated by Zaboklicki be withdrawn consistent with the holding of the Decision.

Claim 20 also stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsuboka in view of Robinson. Similar to claim 2, the Decision recognizes that identifying content of the second medium is accomplished by the user.

The selected page of the program-related teletext page is
“generated based on identifying content of the second medium,”
i.e. , the viewer watches and listens to the television program and
identifies content of the teletext page and the viewer’s selection of
a page causes a presentation to be generated in human-readable
form on the screen.

Decision at 124. Claim 70 is not rejected as being unpatentable over Tsuboka in view of Robinson. The amendment of claim 20 to more closely correspond to claim 70 clearly sets forth that the microcomputer is controlled to identify content of the second medium. Tsuboka in view of Robinson does not teach or suggest this limitation for the reasons set forth in the Decision. Accordingly, these amendments avoid the teachings of Tsuboka and Robinson without raising new issues for consideration by the Examiner. Applicants respectfully request that the rejection of claim 20 as being unpatentable over Tsuboka in view of Robinson be withdrawn consistent with the holding of the Decision.

Claims 21 and 23 depend from claim 20. These claims are patentable for the reasons set forth above with respect to claim 20. Applicants respectfully request that the rejections of claims 21 and 23 be withdrawn. The cancelation of claim 22 renders the rejection of this claim moot.

3. Claim 26 and Claims Depending Therefrom

Claim 26 as amended sets forth “*said second of said at least two of said plurality of media received in a digital data channel from a remote transmitter station.*” Claim 26 has been amended to include the subject matter previously set forth in dependent claim 83 and further to set forth that the second medium is received from a remote transmitter station. As explained above, claims 1 and 3 of the '490 Patent in view Krüger do not teach or suggest any details of

the reception of the second medium and, thus, do not teach or suggest that the second medium is received in a digital data channel from a remote transmitter station. Additionally, as discussed above, claims 1 and 3 of the '490 Patent cannot form the basis of a double patenting rejection as these claims have been finally determined to be unpatentable during reexamination. Accordingly, for these reasons, applicants respectfully request that the new ground of double patenting rejection against claim 26 be withdrawn.

Claim 26 is further amended to place this claim in a condition for allowance over rejections affirmed by the Board on appeal. As explained below, the amendments incorporate limitations which the Board found to avoid the applied art. Claim 26 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Zaboklicki. Decision at 73-74. Claim 26 is amended to include the subject matter of dependent claim 28. Claim 28 was not rejected as being anticipated by Zaboklicki. Zaboklicki does not teach or suggest a step of “*storing said first of said at least two of said plurality of media at said receiver station*” as set forth by amended claim 26. Accordingly, this amendment avoids the teaching of Zaboklicki without raising new issues for consideration by the Examiner. Applicants respectfully request that the rejection of claim 26 as being anticipated by Zaboklicki be withdrawn consistent with the holding of the Decision.

Claims 27, 82 and 84 depend from claim 26. These claims are patentable for the reasons set forth above with respect to claim 26. Applicants respectfully request that the rejections of claims 27, 82 and 84 be withdrawn. The cancelation of claims 28 and 83 renders the rejections of these claims moot.

4. Claim 29 and Claims Depending Therefrom

Claim 29 as amended sets forth that the execution of processor instructions caused by processing a control signal results in processing “*data received in a second medium from an external source.*” Claim 29 has been amended to include the subject matter previously set forth in dependent claim 92 and further to set forth that the second medium is received from an external source. In the Decision, the “instruct-to-overlay” signal of claim 1 of the '490 Patent is relied upon to show the recited “control signal” of claim 29. Decision at 166. The “instruct-to-overlay” signal is asserted to be an instruction that causes the computer to generate an “overlay” of “user specific information.” *Id.* With respect to claim 92 the Decision states:

The overlay is produced by executing processor instructions as recited in claim 92.

Decision at 168. There is however no suggestion that the overlay is produced by processing data received in a second medium from an external source. Accordingly, the amendment to claim 29 avoids the teaching of claims 1 and 3 of the '490 Patent. Krüger is relied upon to teach identifying content of a television program. Krüger does not teach or suggest receiving data in a second medium from an external source that is processed to create a series of images. Additionally, as discussed above, claims 1 and 3 of the '490 Patent cannot form the basis of a double patenting rejection as these claims have been finally determined to be unpatentable during reexamination. Accordingly, for these reasons, applicants respectfully request that the new ground of double patenting rejection against claim 29 be withdrawn.

Claims 30, 91, 93 and 94 depend from claim 29. These claims are patentable for the reasons set forth above with respect to claim 29. It should be noted that claim 94 stands allowable in the Decision. Applicants respectfully request that the rejections of claims 30, 91 and 93 be withdrawn. The cancellation of claim 92 renders the rejection of this claim moot.

5. Claim 37 and Claims Depending Therefrom

Claim 37 as amended sets forth "*a first medium received in a digital data channel.*" Claim 37 has been amended to include the subject matter previously set forth in dependent claim 68. Claim 37 is further amended to set forth that the first medium is included in the plurality of signals received from a source external to the multimedia presentation apparatus. As explained above, claims 1 and 3 of the '490 Patent in view Krüger do not teach or suggest any details of the reception of the first medium and, thus, do not teach or suggest that the first medium is received in a digital data channel from a source external to the receiver station. Additionally, as discussed above, claims 1 and 3 of the '490 Patent cannot form the basis of a double patenting rejection as these claims have been finally determined to be unpatentable during reexamination. Accordingly, for these reasons, applicants respectfully request that the new ground of double patenting rejection against claim 37 be withdrawn.

Claim 37 is further amended to place this claim in a condition for allowance over rejections affirmed by the Board on appeal. As explained below, the amendments incorporate

limitations which the Board found to avoid the applied art. Claim 37 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Zaboklicki. Decision at 72-74. Claim 37 is an apparatus claim that corresponds to the process claim 2. Claim 37 has been amended similarly to claim 2 to set forth that “*said content of said second medium explains a significance of said presentation using said information.*” For the reasons set forth above with respect to claim 2, Zaboklicki does not teach or suggest this claim element. Claim 37 as amended is not anticipated by Zaboklicki. This amendment avoids the teaching of Zaboklicki without raising new issues for consideration by the Examiner. Applicants respectfully request that the rejection of amended claim 37 as being anticipated by Zaboklicki be withdrawn consistent with the holding of the Decision.

Claim 37 also stands rejected under 35 U.S.C. § 103(a) as being obvious over Tsuboka in view of Robinson. Decision at 125-126. The Decision asserts:

[C]laim 37 does not distinguish over the Examiner’s interpretation that the user determines content of the program by listening and viewing the program, where the “content” is a page number of a program-related teletext page referred to in the news program in Robinson, and that the step of coordinating is “based on determining content of the program” because the viewer selects the page number based on his determining content. By contrast claim 70 recites a “microcomputer for identifying content of said first medium” which excludes a human performing the steps; note that claim 70 is not rejected.

Decision at 125-26. Claim 37 is amended to expressly set forth that the microcomputer “*determines content of a received second medium of said at least two media.*” Thus, in accordance with the reasoning set forth in the Decision claim 37 as amended is patentable over Tsuboka in view of Robinson. Neither Tsuboka nor Robinson teach or suggest a microcomputer that determines content of a second medium. Accordingly, these amendments avoid the teachings of Tsuboka and Robinson without raising new issues for consideration by the Examiner. Applicants respectfully request that the rejection of claim 37 as being unpatentable over Tsuboka in view of Robinson be withdrawn consistent with the holding of the Decision.

Claims 38-42, 67 and 69 depend from claim 37. These claims are patentable for the reasons set forth above with respect to claim 37. Applicants respectfully request that the

rejections of claims 38-42, 67 and 69 be withdrawn. The cancellation of claim 68 renders the rejection of this claim moot.

6. Claim 70 and Claims Depending Therefrom

Claim 70 as amended sets forth a microcomputer for “*receiving said second medium in a digital data channel transmitted from a source external to said multimedia presentation apparatus.*” Claim 70 has been amended to include the subject matter previously set forth in dependent claim 72 and further to set forth that the second medium is transmitted from a source external to the multimedia presentation apparatus. As explained above, claims 1 and 3 of the '490 Patent in view Krüger do not teach or suggest any details of the reception of the second medium and, thus, do not teach or suggest that the second medium is received in a digital data channel transmitted from a source external to the multimedia presentation apparatus. Additionally, as discussed above, claims 1 and 3 of the '490 Patent cannot form the basis of a double patenting rejection as these claims have been finally determined to be unpatentable during reexamination. Accordingly, for these reasons, applicants respectfully request that the new ground of double patenting rejection against claim 70 be withdrawn.

Claim 70 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Decision at 44-49. The Decision finds:

Claim 70 does not recite that the microcomputer is for “identifying content of said second medium” or that the microcomputer generates “information based on said second medium . . . based on identifying content of said second medium.”

Decision at 47-48. The Decision goes on to state:

The functions “generated” and “identifying content” are purely functional and, therefore, indefinite under § 112 ¶ 2 because they are not expressly tied to any specific structure, such as the microcomputer structure.

Decision at 49. Claim 70 is amended to place this claim in condition for allowance by complying with the reasoning in the Decision regarding the holding of indefiniteness. Claim 70 is amended to expressly set forth that the microcomputer is for “*identifying content of said*

second medium” and is for “*generating information based on said second medium based on said identifying content of said second medium.*” Applicants submit that these amendments render claim 70 definite in accordance with the reasoning set forth in the Decision. Applicants respectfully request that the rejection of claim 70 as indefinite be withdrawn consistent with the holding of the Decision.

Claims 71 and 73 depend from claim 70. These claims are patentable for the reasons set forth above with respect to claim 70. Applicants respectfully request that the rejections of claims 71 and 73 be withdrawn. The cancellation of claim 72 renders the rejection of this claim moot.

7. Claim 76 and Claims Depending Therefrom

Claim 76 as amended sets forth that the second medium is received “*in a digital data channel from a source external to said multimedia presentation apparatus.*” Claim 76 has been amended to include the subject matter previously set forth in dependent claim 80 and further to set forth that the second medium is received from a source external to said multimedia presentation apparatus. As explained above, claims 1 and 3 of the '490 Patent in view Krüger do not teach or suggest any details of the reception of the second medium and, thus, do not teach or suggest that the second medium is received in a digital data channel from a source external to the multimedia presentation apparatus. Additionally, as discussed above, claims 1 and 3 of the '490 Patent cannot form the basis of a double patenting rejection as these claims have been finally determined to be unpatentable during reexamination. Accordingly, for these reasons, applicants respectfully request that the new ground of double patenting rejection against claim 76 be withdrawn.

Claim 76 is further amended to place this claim in a condition for allowance over rejections affirmed by the Board on appeal. As explained below, the amendments incorporate limitations which the Board found to avoid the applied art. Claim 76 stands rejected under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 4,413,281 (“Thonnart”) and Zaboklicki. Decision at 101-104. Claim 76 is amended to include the subject matter of dependent claim 77. The Board reversed the rejection of claim 77 as being anticipated by Thonnart and Zaboklicki. Claim 77 set forth, and claim 76 is amended to set forth, that the

microcomputer controls “*storage of information based on said second medium.*” The Decision holds:

We do not find where Zaboklicki controls storage of . . .
“information based on said second medium” where the “second
medium” is the secondary audio.

Decision at 104-105. Accordingly, the incorporation of this subject matter into claim 76 overcomes the rejection over Thonnart and Zaboklicki. This amendment avoids the teachings of Thonnart and Zaboklicki without raising new issues for consideration by the Examiner. Applicants respectfully request that the rejection of claim 76 as being unpatentable over Thonnart and Zaboklicki be withdrawn consistent with the holding of the Decision.

Claims 78, 79 and 81 depend from claim 76. These claims are patentable for the reasons set forth above with respect to claim 76. Applicants respectfully request that the rejections of claims 78, 79 and 81 be withdrawn. The cancelation of claims 77 and 80 renders the rejections of these claims moot.

8. Claim 85 and Claims Depending Therefrom

Claim 85 as amended sets forth the creation of a series of discrete video images by processing processor instructions to process “*data received in a second medium from an external source.*” Claim 85 has been amended to include the subject matter previously set forth in dependent claim 88 and further to set forth that the second medium is received from an external source. With regard to the rejection of claims 85 and 88, the Decision states:

The computer processes “user specific information” in the computer to create the overlay, which is a “discrete video image,” as recited in claim 88 One of ordinary skill in the computer art would have considered it obvious to receive the “user specific information” in ‘490 patent claim 1, which corresponds to the second medium, over a “digital data channel” as recited in claim 89 because the “user specific information” is digital data stored in a computer and must somehow be received from outside the computer. A “channel” is a data path that could be the path from the computer keyboard to the computer.

Decision at 171. There is however no suggestion that the “user specific information” in claim 1 of the ‘490 patent is received from an external source. To the contrary, the Board recognized that the “user specific information” as set forth by claim 1 of the ‘490 patent could be received from a computer keyboard of the presentation apparatus. Accordingly, the amendment to claim 85, setting forth that the data is received from an external source, avoids the teaching of claims 1 and 3 of the ‘490 Patent. Krüger is relied upon to teach identifying content of a television program. Krüger does not teach or suggest receiving data in a second medium from an external source. Additionally, as discussed above, claims 1 and 3 of the ‘490 Patent cannot form the basis of a double patenting rejection as these claims have been finally determined to be unpatentable during reexamination. Accordingly, for these reasons, applicants respectfully request that the new ground of double patent rejection against claim 85 be withdrawn.

Claims 86, 87, 89 and 90 depend from claim 85. These claims are patentable for the reasons set forth above with respect to claim 85. Applicants respectfully request that the rejections of claims 86, 87, 89 and 90 be withdrawn. The cancellation of claim 88 renders the rejection of this claim moot.

III. AMENDMENT OF CLAIMS NOT SUBJECT TO NEW GROUND OF REJECTION

A. CLAIM 24 AND CLAIM DEPENDING THEREFROM

As a result of the Decision, claim 103, depending from claim 24, stands without rejection. Decision at 175.⁵ Claim 24 is amended to include the subject matter of claim 103. The scope of claim 24 as amended is identical to claim 103 as it stood without rejection. The amendment to claim 24 accepts the Decision of the Board and advances the prosecution of this application toward allowance. Applicants respectfully submit that claim 24 as amended and claim 25 depending therefrom are patentable for the reasons set forth in the Decision with respect to claim 103.

⁵ See Decision at 84 – 85 for reversal of rejection under 35 U.S.C. § 103(a) as being unpatentable over Barnaby and Okada. See Decision at 149-51 for reversal of double patenting rejection.

B. CLAIM 33 AND CLAIMS DEPENDING THEREFROM

As a result of the Decision, claim 35, depending from claim 33, stands without rejection. Decision at 175.⁶ Claim 33 is amended to include the subject matter of claim 35. The scope of claim 33 as amended is identical to claim 35 as it stood without rejection. The amendment to claim 33 accepts the Decision of the Board and advances the prosecution of this application toward allowance. Applicants respectfully submit that claim 33 as amended and claims 34, 36, 101 and 102 depending therefrom are patentable for the reasons set forth in the Decision with respect to claim 35.

C. CLAIM 74 AND CLAIM DEPENDING THEREFROM

As a result of the Decision, claim 104, depending from claim 74, stands without rejection. Decision at 175.⁷ Claim 74 is amended to include the subject matter of claim 104. The scope of claim 74 as amended is identical to claim 104 as it stood without rejection. The amendment to claim 74 accepts the Decision of the Board and advances the prosecution of this application toward allowance. Applicants respectfully submit that claim 74 as amended and claim 75 depending therefrom are patentable for the reasons set forth in the Decision with respect to claim 104.

D. CLAIM 95 AND CLAIMS DEPENDING THEREFROM

As a result of the Decision, claim 98, depending from claim 95, stands without rejection. Decision at 175.⁸ Claim 95 is amended to include the subject matter of claim 98. The scope of claim 95 as amended is identical to claim 98 as it stood without rejection. The amendment to claim 95 accepts the Decision of the Board and advances the prosecution of this application toward allowance. Applicants respectfully submit that claim 95 as amended and

⁶ See Decision at 100-01 for reversal of rejection under 35 U.S.C. § 103(a) as being unpatentable over Morchand and Zaboklicki. See Decision at 111-14 for reversal of rejection under 35 U.S.C. § 103(a) as being unpatentable over Zaboklicki, Field and Laviana, further in view of Soejima. See Decision at 149-51 for reversal of double patenting rejection.

⁷ See Decision at 86 for reversal of rejection under 35 U.S.C. § 103(a) as being unpatentable over Barnaby and Okada further in view in Betts. See Decision at 149-51 for reversal of double patenting rejection.

⁸ See Decision at 111-14 for reversal of rejection under 35 U.S.C. § 103(a) as being unpatentable over Zaboklicki, Field and Laviana, further in view of Soejima. See Decision at 149-51 for reversal of double patenting rejection.

claims 96, 97, 99, and 100 depending therefrom are patentable for the reasons set forth in the Decision with respect to claim 98.

IV. REQUEST FOR INTERVIEW

It is applicants intention to amend the claims of this application in accordance with the Decision of the Board to place this application in a condition for allowance. Applicants believe that above amendments do place this application in condition for allowance. Applicants, however, desire the opportunity to discuss these amendments with the Examiner to ensure agreement that the claims are in a condition for allowance. It is applicants understanding that the jurisdiction of this application will not be transferred from the Board to the Examiner until after this amendment is filed. Applicants request that once jurisdiction has been transferred to the Examiner that the undersigned applicants' representative be contacted to schedule a personal interview with the Examiner to discuss the claim amendments set forth above.

V. CONCLUSION

In view of the above amendment, applicants believe the pending application is in condition for allowance. Reconsideration of the new ground of rejection asserted in the Decision and allowance of the instant application are respectfully requested.

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Respectfully submitted,

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